

REMARKS

Reconsideration of this application and entry of this Amendment is respectfully requested. New independent composition claim 38 replaces independent claim 1 which has been cancelled. New independent composition claim 38 incorporates the recitations of claims 6, 23, 27 and 29 which have been cancelled.

Claim 38 represents a sincere effort to more precisely define the invention and to expedite the allowance of this patent application. Claim 38 recites the specific weight % of effective keratin conditioning agent, the mascara base as an oil-in-water emulsion, and the weight % of the water phase and the oil phase. Support for these recitations can be found in the specification at page 3, lines 17-22 and page 7, lines 5-7. Claim 38 also recites a cosmetically acceptable wax component. Support for this recitation can be found in the specification at page 2, line 19 and page 3 line 11 and original claims 27 and 29. Claim 38 also recites the weight % of the emulsifier. Support for this recitation can be found in the specification at page 5, lines 8-9. Claim 38 also recites the viscosity of the mascara composition. Support for this recitation can be found in original claim 23. Claim 38 also recites that the composition is adapted to be gentle to eyelashes and readily washed off. Support for this recitation can be found in the specification at page 5, lines 14-17 and page 8, lines 9-13. Method claim 37 has been amended to incorporate the limitations of claim 38. No new matter has been added.

Before discussing the issues raised by the Examiner in the Office Action, it is believed worthwhile at this point to briefly discuss the novel aspects of the claimed invention and the unexpected advance it brings to the state-of-the-art.

Applicants' claimed invention represents a significant advance in the state-of-the-art in developing a mascara composition with a conditioning agent which provides a long lasting mascara without the need for high levels of waxes and film formers contained in conventional mascaras. Because the inventive mascara composition has significantly lower wax content coupled with its lower emulsifier surfactant content, it is gentle to the eyelashes and readily removed by washing with water without damaging the eyelashes.

In contrast, conventional mascara compositions that incorporate high levels of waxes and film formers are difficult to remove and wash off, which in turn can cause damage to the eyelashes. See the specification on page 1, lines 3-9, titles included.

The conventional wisdom to practitioners in the art is that a mascara composition with a low level of waxes and film formers would disadvantageously shorten the time that the mascara would remain on the eyelashes and make the mascara easier to smudge and smear.

Applicants' claimed invention, has proceeded against the accepted conventional wisdom of practitioners in the art and has unexpectedly produced a gentle mascara composition that readily washes off and provides the benefits of conventional mascaras in terms of long wear, and thickening and lengthening the eyelashes.

Applicants' claimed invention has unexpectedly resulted in a gentle, water based conditioning mascara with long wear properties without the high wax content that can damage the eyelashes.

The viscosity properties recited in the claims underscores the softness and gentleness of the inventive composition using soft waxes. As noted, the use of soft waxes is contrary to the conventional wisdom of practitioners in the art because of the belief that soft waxes would not provide long wear, and would have a tendency to cause the mascara composition to smear and smudge.

Thus, applicants' invention is not the mere selection of known elements combined together with no new function or unpredictable result, but rather an unexpected and unpredictable result occurring from an inventive approach that was contrary to the conventional wisdom of practitioners in the art.

Turning now to the Office Action, the rejection of claims 2 and 3 under the second paragraph of 35 USC § 112 as lacking antecedent basis is believed obviated in view of the changed dependency of claims 2 and 3 on new claim 38, which recites the phrase "*other sources of amino acids*" in the Markush group of keratin conditioning agents. Therefore, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1-4, 6-9, 23-26, 28 and 32-37 have been rejected under 35 USC § 102 as anticipated by U.S. Patent No. 6,264,933 to *Bodelin et al.* This ground of rejection

is respectfully traversed. In order to anticipate a claim, the reference must contain every element and limitation of the claimed invention, arranged as in the claim *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375 (Fed. Cir. 2001). *Bodelin* does not fulfill this requirement.

Bodelin discloses a cosmetic composition comprising an aqueous phase dispersed in a liquid fatty phase that contains at least one volatile organic solvent. The aqueous phase contains a polymer system comprising at least one film-forming polymer of solid particles dispersed in the aqueous phase. The composition also comprises at least one lamellar filler (column 1, lines 55-63). Contrary to applicants' claimed invention, *Bodelin*'s composition is waterproof (col 1, lines 46-48), and thus, not readily removable by washing in water.

Bodelin does not disclose a keratin conditioning agent in amounts that vary from "about 0.5 to about 5.0 weight %" of the total composition. This parameter is recited in the claimed invention and is necessary to achieve the conditioning effect of applicants' claimed invention. The wheat protein hydrolysate referred to by the Examiner in *Bodelin* appears to exist only in Examples 1 and 2 in an amount equivalent to about 0.18 weight % of the total composition. This amount does not approach the 0.5 weight % lower limit of the keratin conditioning agent claimed by applicants. Examples 3 and 4 of *Bodelin* do not appear to contain a keratin conditioning agent.

Bodelin also discloses the total weight of the aqueous phase in the composition ranges from 1-35 weight % (column 4, lines 26-29), and the total weight of the liquid fatty phase ranges from 65-99 percent by weight (column 8, lines 64-67).

In contrast, applicants claimed composition recites an oil-in-water emulsion comprised of an aqueous phase that varies from about 50-75 weight %, and an oil phase that varies from about 25-50 weight % of the total composition. As already noted, the inventive composition is readily washed off because of its low wax and film former content (page 8, lines 12-13).

It is respectfully submitted that *Bodelin* is fatally deficient not only under 35 USC § 102, but under 35 USC § 103 because there is no anticipation or obvious basis contained in *Bodelin et al* for suggesting applicants' claimed invention. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 1-4, 6-10, 23-26, 28, 32-37 under 35 USC § 102 as anticipated by U.S. Patent No. 6,274,131 to *Piot et al* is respectfully traversed.

Piot et al discloses a mascara composition comprising a wax-in-water emulsion of a mixture of hard waxes and a film-forming polymer (column 1, lines 43-67).

In contrast, applicants' claimed composition is a long wear, water-based conditioning formulation that is gentle to the hair and requires a soft wax material. See the specification at page 1, lines 1-18 (titles included), at page 2, lines 11-21 and page 5, lines 10-17.

Piot et al does not disclose wheat protein hydrolysate as having a conditioning function in an amount effective to improve the aesthetic appearance of a keratinous fiber to which the mascara composition is applied. In applicants' claimed invention the keratin conditioning agent has a lower limit of 0.5 weight % of the total composition.

In examples 1, 2 and 8 of *Piot et al*, the wheat protein hydrolysate components have weight percents of 0.23, 0.29 and 0.22 respectively, of the total composition. This does not approach the lower limit of 0.5 weight % of keratin conditioning agent in applicants' claimed invention. It is respectfully submitted that there is no basis under 35 USC § 102 or 35 USC § 103 for *Piot* to anticipate or make obvious the claimed invention. Accordingly, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1, 2, 6-10, 23-26 and 32-37 have been rejected under 35 USC § 102 as anticipated by U.S. Patent No. 5,053,221 to *Robertson et al*. This ground of rejection is respectfully traversed.

Robertson's composition does not contain waxes or fibers (column 1, lines 22-24). Soft waxes are an essential component of applicants' claimed invention. In addition, *Robertson* does not include oils in his mascara composition (column 1, lines 41-44).

Applicants' claimed invention is an oil-in-water emulsion. *Robertson* does not disclose an oil-in-water emulsion and does not disclose each and every element of the claimed invention. Therefore, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1-4, 6-18 and 22-37 have been rejected under 35 USC § 103 as unpatentable over Bodelin et al and U.S. Patent 6,214,329 to Brieva et al. The deficiencies of Bodelin have already been discussed and are applicable to this ground of rejection. The combination of Brieva et al with Bodelin et al does not resolve the deficiencies of the rejection, but rather compounds them.

Brieva discloses a gel based mascara where the viscosity usually achieved with wax is instead achieved with non-wax gelling agents (column 1, lines 46-50). Brieva's composition comprises an aqueous phase and a non-aqueous phase wherein the non-aqueous phase ingredients include lipophilic non-polar or slightly polar materials such as waxes, hydrocarbons, fats, oils, and the like, in addition to one or more organic, solid, non-polymer gelling agents (column 2, lines 26-35).

The organic solid non-polymer gelling agent in Brieva includes fatty acids, esters, amides of fatty acid gellants, hydroxy acids, hydroxy fatty acids and other types of amide gellants (column 2, lines 58-66). Waxes and oil are optional ingredients (column 5, lines 16-17 and column 6, lines 7-8).

Brieva does not appear to disclose a keratin conditioning agent similar to that of applicants' claimed invention. Moreover, Brieva would appear to lead away from the claimed invention by disclosing a non-aqueous gelling agent that is incompatible with the teachings of Bodelin et al and applicants' claimed invention.

There is no disclosure or obvious suggestion in either Bodelin or Brieva of an easily washable mascara composition gentle to eyelashes comprising a mascara base and a keratin conditioning agent in an amount effective to improve the aesthetic appearance of a keratinous fiber to which the mascara composition is applied. As already noted, applicants' claimed invention has produced unexpected results because it proceeded against conventional wisdom and resulted in a gentle, long wearing mascara composition readily removable by washing and without a high wax content.

Applicants' previous Amendment pointed out the flaws of the combination of Bodelin and Brieva patents in combination as well as the importance of functional language in a claim. If the Examiner continues this ground of rejection it is respectfully requested that the issues raised by Applicants' discussion of In re Caldwell,

138 USPQ 243 (CCPA 1963) in their previous Amendment be addressed by the Examiner.

Lastly, claim 5 has been rejected under 35 USC § 103 as unpatentable over the combination of Bodelin et al and Brieva et al further in view of the Croda brochure. This ground of rejection is respectfully traversed.

The deficiencies of Bodelin et al and Brieva et al have already been discussed and are similarly applicable to this ground of rejection. The Examiner's further reliance on the Croda brochure does not resolve the deficiencies of the rejection because Croda's disclosure with regard to "Keravis" is directed to hair care on the scalp and not eyelash hair fiber care.

Keravis is described in Croda as a moisturizer. A moisturizer is not the same as a conditioner. See applicants' specification at page 1, lines 7-9 (*titled included*). Moreover, a conditioner for scalp hair is not the same as a conditioner for eyelash hair. Scalp hair and eyelash hair are different body parts. Most scalp hair care compositions contain components that would be irritating if contacted with eyelash hair. For example, one would not use a scalp hair shampoo on eyelashes, and many scalp hair shampoo products caution against use near the eyes. Thus, it is respectfully submitted that the effort to combine Croda with Bodelin and Brieva would lead away from applicants' claimed invention and further compound the deficiencies of the rejection.

In view of the above Amendments and Remarks, it is respectfully submitted that this application is now in condition for allowance and such favorable action is respectfully requested.

Respectfully submitted,

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